

MAR 9 1990

IN THE SUPREME COURT OF THE UNITED STATES

JOSEPH P. SPANIOLO, JR.
CLERK

October Term 1989

No. _____

IRVIN D. STAGNER,
Pro Se Petitioner-Appellant

v.

UNITED STATES PATENT & TRADEMARK OFFICE,
COMMISSIONER OF PATENTS, DONALD QUIGG,
DEPUTY ASSISTANT COMMISSIONER, JAMES E.
DENNY, PETITION EXAMINER, JEFFREY V.
NASE, DIRECTOR OF PATENT EXAMINING
GROUP 320, SAMIH N. ZAHARNA, SUPERVISOR
OF PATENT EXAMINING GROUP 320, FREDERICK
R. SCHMIDT, PATENT EXAMINERS OF GROUP
320, JAMES G. SMITH AND DEBRA MEISLIN

Appellees

PETITION FOR WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

APPENDIX A

Petitioner Pro Se
Irvin D. Stagner
1814 Ellis
Wichita, KS 67211
316 264 2723



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Pursuant S. Ct. Rule 14.2 appendix
as separate document

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Note: This opinion has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

UNITED STATES COURT OF APPEALS FOR THE
FEDERAL CIRCUIT

89-1724

IRVIN D. STAGNER,
Plaintiff-Appellant,

v.

UNITED STATES PATENT & TRADEMARK OFFICE,
COMMISSIONER OF PATENTS, DONALD QUIGG,
DEPUTY ASSISTANT COMMISSIONER, JAMES E.
DENNY, PETITION EXAMINER, JEFFREY V.
NASE, DIRECTOR OF PATENT EXAMINING
GROUP 320, SAMIH N. ZAHARNA, SUPERVISOR
OF PATENT EXAMINING GROUP 320, FREDERICK
R. SCHMIDT, PATENT EXAMINERS OF GROUP
320, JAMES G. SMITH AND DEBRA MEISLIN

Defendant-Appellees,

DECIDED: January 25, 1990

Before ARCHER, Circuit Judge, COWEN,
Senior Circuit Judge. and MAYER, Circuit
Judge.

PER CURIAM

DECISION

The June 29, 1989, Memorandum and Order of the United States District Court for the District of Kansas, granting summary judgment against plaintiff-appellant, Irvin D. Stagner, in three consolidated cases, Stagner v. United States Patent and Trademark Office, 11 USPQ2d 1553 (D. Kan. 1989), is affirmed.

OPINION

The present action arises from a lengthy history of patent prosecution in the United States Patent and Trademark Office (PTO) by the appellant, proceeding pro se. Following the PTO proceedings, he filed three civil actions in the United States District Court for the District of Kansas. In an initial decision of May 6, 1988, the district court dismissed the suit for lack of jurisdiction. Stagner v.

United States Patent and Trademark Office. 8 USPQ2d 1173 (D. Kan. 1988). Since Mr. Stagner failed to exhaust his administrative remedies, the district court determined it had no jurisdiction.

However, on reconsideration, the district court determined that it had jurisdiction over Stagner's due process claim based on 28 U.S.C. §§ 1338, covering all actions arising under the patent laws, and 28 U.S.C. §§ 1361 covering actions for mandamus.

In its reconsideration decision, the district court granted summary judgment against Stagner in the three consolidated cases. *Stagner v. United States Patent and Trademark Office*, 11 USPQ2d 1553 (D. Kan. 1989). The present appeal, which is from that decision, was transferred to this court from the Tenth Circuit.

We agree with the district court's

determination that "the plaintiff has failed to allege any instances in which the patent procedure denied him due process, or any situation in which the Commissioner acted arbitrarily, capriciously, or contrary to law." See Celotex Corp. v. Catrett, 477 U. S. 317 (1986). Mr. Stagner has failed to establish any ground for reversing the court's decision and we find none.

Mr. Stagner argues that the district court, "wrongly construed the complaints filed by the plaintiff-appellant against the defendants-appellees into a merit issue from a clear procedure issue." However, as the district court correctly observed in its decision of May 6, 1988, "the gist of plaintiff's complaint is that he was unlawfully deprived of issuance of a patent and wishes this to review the denial." Moreover, a review of appellant's amended complaint shows that

his basic contention is that the PTO examiner wrongfully and erroneously rejected his application for a patent. Thus, Mr. Stagner's dispute with the examiner's grounds for rejection are disputes on the merits of his applications. Although Mr. Stagner's suits in the district court were premature, the thorough and well-reasoned opinions of that court show that he was accorded all the rights to which he was entitled as a pro se plaintiff.

Finally, we note that our decision in this appeal does not leave Mr. Stagner without a remedy. His fourth patent application is still pending in the PTO. If it is finally rejected by the examiner, he can appeal within the PTO and if dissatisfied with that decision, he can seek judicial review pursuant to either 35 U.S.C. @@ 141 or @@ 145.

UNITED STATES COURT OF APPEALS FOR THE
TENTH CIRCUIT

89-3175

IRVIN D. STAGNER,
Plaintiff-Appellant,

V.

UNITED STATES PATENT & TRADEMARK OFFICE,
COMMISSIONER OF PATENTS, DONALD QUIGG,
DEPUTY ASSISTANT COMMISSIONER, JAMES E.
DENNY, PETITION EXAMINER, JEFFREY V.
NASE, DIRECTOR OF PATENT EXAMINING
GROUP 320, SAMIH N. ZAHARNA, SUPERVISOR
OF PATENT EXAMINING GROUP 320, FREDERICK
R. SCHMIDT, PATENT EXAMINERS OF GROUP
320, JAMES G. SMITH AND DEBRA MEISLIN

Defendant-Appellees,

ORDER

Before MOORE and EBEL, Circuit Judges.

Appellee's motion to transfer this
appeal to the United States Court of
Appeals for the Federal Circuit is
granted.

FILED SEPT. 5/ 89

UNITED STATES COURT FOR THE DISTRICT OF
KANSAS

87-1713-K

87-1714-K

87-1715-K

IRVIN D. STAGNER,

V.

UNITED STATES PATENT & TRADEMARK OFFICE,
COMMISSIONER OF PATENTS, DONALD QUIGG,
DEPUTY ASSISTANT COMMISSIONER, JAMES E.

DENNY, PETITION EXAMINER, JEFFREY V.

NASE, DIRECTOR OF PATENT EXAMINING
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R. SCHMIDT, PATENT EXAMINERS OF GROUP
320, JAMES G. SMITH AND DEBRA MEISLIN

JUDGMENT IN A CIVIL CASE

 Jury Verdict. This action came before
the Court for a trial by jury. the
issues have been tried and the jury has
rendered its verdict.

 X Decision by the Court. This action
came to trial or hearing before the
Court. The issues have been tried or
heard and a decision has been rendered.

IT IS ORDERED AND AJUDGED that the
motion for summary judgment filed by the
defendants, and each of them, is granted.

FILED JUNE 29, 1989

IN THE UNITED STATES COURT FOR THE
DISTRICT OF KANSAS

87-1713-K FILED
87-1714-K JUN 29/89
87-1715-K

IRVIN D. STAGNER,
Plaintiff,

v.

UNITED STATES PATENT & TRADEMARK OFFICE;
COMMISSIONER OF PATENTS, DONALD QUIGG;
DEPUTY ASSISTANT COMMISSIONER, JAMES E.
DENNY; PETITION EXAMINER, JEFFREY V.
NASE; DIRECTOR OF PATENT EXAMINING
GROUP 320, SAMIH N. ZAHARNA; SUPERVISOR
OF PATENT EXAMINING GROUP 320; FREDERICK
R. SCHMIDT; PATENT EXAMINERS OF GROUP
320, JAMES G. SMITH AND DEBRA MEISLIN,

Defendants.

MEMORANDUM AND ORDER

In these three consolidated actions, PRO SE plaintiff Irvin D. Stagner seeks money damages for the alleged wrongful denial of his patent applications. Plaintiff brought this action against the United States Patent and Trademark Office, the Commissioner

of Patents, and a number of other individuals in the patent office, who are collectively referred to here as the defendants. This case is currently before the court on defendants' motion to dismiss or in the alternative for summary judgment. Before considering the current motion, however, it is useful to first briefly review the procedural history of these consolidated cases to this point.

In a memorandum and order dated May 9, 1988, this court found that it lacked subject matter jurisdiction and/or venue over plaintiff's complaint. The court reasoned that the "gist" of plaintiff's "prolix" complaint "is that he was unlawfully deprived of the issuance of a patent and wishes this court to review the denial." *Stagner v. United States Patent and Trademark Office, et al.*, Nos. 87-1713, -1714 & -1715, slip op. at 3 (D. Kan. May 9,

1988). The court held that it lacked jurisdiction over the subject matter of plaintiff's complaint because the applicant is first required to present his claims to the Board of Patent Appeals prior to resort to the courts, and the applicant may then obtain judicial review only in the District Court for the District of Columbia. The court concluded:

In this case, as far as the court can discern from the complaint, the plaintiff has not exhausted his administrative remedies -- i.e., he has not appealed to the Board of Patent Appeals. Thus, the court lacks subject matter jurisdiction. Moreover, even if he had exhausted his administrative remedies, venue would not be proper in this court pursuant to [35 U.S.C.] @145.

Id. at pp. 3-4.

Plaintiff subsequently filed a motion for reconsideration of the court's dismissal, in which he pointed out that after his patent applications were rejected for reasons other than on

the merits, he petitioned the Commissioner of Patent and Trademarks ("Commissioner") as authorized by 37 C.F.R. @1.181(a). The Commissioner subsequently dismissed his petitions and plaintiff contended that the Commissioner's action violated his constitutional right to due process.

The court found that the express statutory avenues of judicial review discussed in its previous order are limited to rejection of claims on the merits by the Board of Patent Appeals, but that decisions of the Commissioner may be reviewed by way of mandamus. Accordingly, the court found it had subject matter over plaintiff's action pursuant to 28 U.S.C. @1338, covering all actions arising under the patent laws, and 28 U.S.C. @1336, covering actions for mandamus. The court concluded:

Upon review, it appears that plaintiff has at least

alleged a due process violation and that this court may assert jurisdiction pursuant to 28 U.S.C. §§ 1338 and 1361. The complaint herein is of such importance to the litigant, and the area of the law is so complex, that plaintiff Stagner is advised by the court to obtain counsel in this matter and to have counsel file amended complaints which comply with Fed.R.Civ.P. 8. At that time, the court may reevaluate the existence of subject matter jurisdiction in this case.

Stagner v. United States Patent and Trademark Office, et al. Nos. 87-1713, -1714 & -1715, slip op. at 2-3 (D. Kan. June 24, 1988).

Despite the court's suggestion, plaintiff has not obtained counsel to assist him in pursuing his action. He did, however, file amended complaints on July 21, 1988.

Defendants have now renewed their motion to dismiss, or in the alternative for summary judgment, on the basis that plaintiff's allegations are directed to the merits of the denial of his patent

application rather than to procedural deficiencies, and thus, the court cannot exercise mandamus jurisdiction. Further, defendants argue that even if the court exercises mandamus jurisdiction, it must find that the Commissioner's actions in responding to the various petitions filed by plaintiff were not arbitrary, capricious, an abuse of discretion, or contrary to law.

Since both parties have presented the court with matters outside the pleading, the court will treat defendants' motion as one for summary judgment pursuant to Fed.R.Civ.P. 12(b).

Summary judgment is proper where the pleadings, depositions, answer to interrogatories, and admission on file, together with affidavits, if any, show there is not genuine issue as to any material fact, and that the moving party is entitled to is entitled to judgement as a matter of law. Fed.R.Civ. P.

56(c). Summary judgment is appropriate in a patent case, as in any other case. *Barmag Barmer Maschinenfabrik AG v. Murate Machinery, Ltd.*, 731 F.2d 831, 835 (Fed. Cir. 1984). In considering a motion for summary judgment, this court must examine all evidence in a light most favorable to the opposing party. *McKenzie v. Mercy Hospital*, 854 F.2d 365, 367 (10th Cir. 1988). Further, the party moving for summary judgment must demonstrate its entitlement beyond a reasonable doubt. *Ellis v. El Paso Natural Gas Co.*, 754 F.2d 884, 885 (10th Cir. 1985). The moving party need not disprove plaintiff's claim, but rather, must only establish that the factual allegations have no legal significance. *Dayton Hudson Corp. v. Macerich Real Estate Co.* 812 F.2d 1319, 1323 (10th Cir. 1987).

In resisting a motion for summary judgment, the opposing party may not

rely upon mere allegations, or denials, contained in its pleadings or briefs. Rather, the moving party must come forward with specific facts showing the presence of a genuine issue of material fact for trial and significant probative evidence supporting the allegations. *Burnette v. Dresser Industries, Inc.*, 849 F.2d 1277, 1284 (10th Cir. 1988). One of the principal purposes of summary judgment is to isolate and dispose of factually unsupported claims or defenses, and the rule should be interpreted in a way that allows it to accomplish this purpose. *Celotex Corp. v. Catrett*, 477 U.S. 317 (1988).

Defendants have provide the court with copies of the relevant portions of the administrative record of the Patent and Trademark Office. The pages of the administrative record have been renumbered with "Bates" page numbers. In this order, the court will simply

refer to the administrative record as "Record", followed by the appropriate page number.

Findings of Fact

Plaintiff filed his first patent application On August 1, 1983. The application was examined and an office action issued June 12, 1984 by examiner James Smith. Plaintiff's claims were rejected as failing to define the invention in a manner specified by 35 U.S.C. @112. On July 11, 1984, plaintiff filed an amendment to the applications which changed that text of the claims. The patent examiner repeated the rejection under @112 in a final rejection entered September 6, 1984.

A second patent application containing one claim was filed by Stagner on November 13, 1984. On September 13, 1985, this claim was rejected under 35 U.S.C. @112 and 35

U.S.C. @103 (obviousness). (1) On October 15, 1985, Stagner filed a 35-page amendment to his claim, 13 pages of which consist of references to case digests in Title 35 of U.S.C.A. On December 18, 1985, the rejection under @103 was made final. The office action cited three patent references (prior art), and pointed to features in the prior art that render the invention unpatentable.

(1) 35 U.S.C. @103 provides in relevant part:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

On January 2, 1986, Stagner filed a petition to the Commissioner under 37 C.F.R. @1.181, asking for "reexamination and reconsideration" of his application by a different examiner. The petition basically alleged that the examiner failed to make a complete study of Stagner's patent application or a thorough investigation of the available prior art relating to the application. Further, Stagner contended the patent application examiner erred in maintaining a rejection under 35 U.S.C. @103. On that same date, Stagner failed a document which was considered a request for reconsideration of the final rejection. In decision dated February 5, 1986. the examiner indicated that this document did not overcome the final rejection.

The January 2, 1986 petition was answered in a decision dated February 13, 1986. The decision initially points

out that Stagner failed to explain the basis for his contention that the examiner did not conduct a complete investigation. Further, the decision states that a "review of the record indicates that the Examiner has [conducted a complete examination] and thus it is not agreed that he has failed to comply with [37 C.F.R. @1.104(a)]." (Record, p. 0257.) Finally, the decision points out that Stagner's contention that the examiner erred in rejecting his claims on the prior art references is directed entirely to the merits of the examiner's rejection of the claim and "the statutes provide an Appeal procedure to the combined Board of Appeals and Interferences to resolve this differences." Id.

— On March 3, 1986, Stagner filed a document addressed to the Commissioner which was treated as a request for reconsideration of the February 13, 1986

decision. On March 10, 1986, Stagner filed a third patent application and "brief" with exhibits.

On May 15, 1986, the Patent Examining Group Director responded to Stagner's March 3 and March 10 communications. Plaintiff's March 3, 1986 request for reconsideration was granted to the extent that it was itself considered on the merits. Reconsideration of the application itself was denied. Stagner subsequently returned this response to the group director with the notation "Action Voided--Not Acceptable--Voided" written in bold print across the letter. (Record, p. 0396.)

As for plaintiff's March 10, 1986 communications, the group director noted that the "brief" filed by plaintiff "consists of a listing of legal interpretations of the patent statutes and general allegations regarding the

patentability of the combined 90 degree and 45 degree angled socket extension set. This paper has been made a record in the application file but is not responsive to the December 18, 1985 final rejection." (Record, p. 0394.)

In an action issued December 22, 1986, plaintiff's third patent claim was rejected by the examiner under 35 U.S.C. @112 for failing to provide an adequate written description of the invention, and under @103 for obviousness.

On February 19, 1987 Stagner filed four additional documents: a 78-page amendment to be entered in the third application; (2) a copy of a letter previously filed on June 2, 1986; (3) a "petition" to the Commissioner alleging "ex parte" (biased) examination plaintiff's application and failure to follow the rules for examination of applications; and (4) a petition to the Commissioner containing a complaint

against the group director alleging the group director alleging discourteous conduct.

On March 17, 1987, plaintiff filed a "Amendment of An Amendment." The patent office did not enter this document as part of the record because it was unconventional and did not present any amendment to the specification or claim.

Deputy Assistant Commissioner for Patents, James Denny, responded on August 21, 1987, to Stagner's February 19, 1987 petition and complaint to discourteous conduct. Denny advised Stagner that "a careful review" of all the records concerning Stagner's patent applications revealed nothing which would indicate that the examiner acted in any manner inconsistent with the statutes and rules governing the prosecution of application for patents. (Record, p. 06164.) Denny further

explained the distinction between appealable and petitionable matters and advised Stagner to obtain a patent practitioner to advise him in the prosecution of his patent application.

On September 1, 1987, Stagner sent letters to the Commissioner and Deputy Assistant Commissioner complaining of improper examining practices. Examiner Jeff Ness reviewed Stagner's files and concluded that proper examining procedures had been followed. Stagner was again advised that disagreements over the relevance of prior art references must be appealed to the board.

On October 5, 1987, plaintiff filed a letter advising that the third patent application had been abandoned and a fourth application was being filed, and a document entitled "Rebuttal and Remarks." Plaintiff also filed a petition to the Commissioner.

On June 1, 1988 plaintiff's fourth

application was rejected under 35 U.S.C. §§ 112 and 103. Stagner's petition and "Rebuttal and Remarks" were not considered since these papers addressed issues in an abandoned application.

Finally, on July 22, 1988, a letter was issued advising Stagner of a co-pendency problem between his third and fourth applications. This letter apparently was in error and a corrective letter was issued on August 2, 1988.

Conclusions of Law

Prior to considering defendants' argument for summary judgment, the court initially notes that while this decision has been somewhat delayed, at least part of that delay is due to the court's difficulty in interpreting plaintiff's claims and contentions in this technical area of the law. Plaintiff has chosen to ignore the court's admonitions to obtain experienced counsel to assist him, and consequently the court has had

to analyze and consider plaintiff's claims as best it could.

In support of their motion for summary judgement, defendants assert that plaintiff's amended complaints, as well as his deposition testimony and brief filed in response to defendants' summary judgment motion, fail to specify any due process violation in the conduct of the examination of plaintiff's patent application or any breach of duty by the Commissioner with respect to plaintiff's various petitions.

Plaintiff responds to defendants' arguments by making numerous promises to "prove at a trial" that defendants deprived him of due process in the processing of his patent applications. Plaintiff may not, however, resist a motion for summary judgement by relying on mere allegations or denials contained in pleading or briefs, but rather, must come forward with specific facts showing

a genuine issue of material fact for trial. Fed.R.Civ.P. 56(e).

Although this briefs and amended petition are convoluted and difficult to follow, the court discerns that plaintiff's primary complaint is that the examiners did not address each and every issue raised in his petitions, nor did they respond to every case cited in his "briefs" and "rebuttals". As is apparent from the detailed procedural history recited in the fact-finding portion of this memorandum, each document filed by the petitioner was considered and acted upon by the Commissioner.

Moreover, questions concerning the sufficiency and correctness of the examiner's determinations go to the merits of plaintiff's allegations and are thus not within this court's jurisdiction. Where plaintiff disputes a denial of patent claims based on prior

art or material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to the merits. In re James, 432 F.2d 473, 475 (CCPA 1970); In re Weichert, 370 F.2d 927, 938 (CCPA 1967). As this court has previously noted, appeals on the merits must be made to the Board of Patent Appeals prior to resort to the court. See generally 3 CHISUM, Patents @11.06 (1988).

That plaintiff's complaints go to the merits of the denial of his applications is further supported by his request that the court "Grant Letters of Patent in accordance with Title 35 USCA and 37 CFR as proven by the Plaintiff." (Plaintiff's Response, p. 5.) Until plaintiff obtains a review of the merits of the rejections by the Board of Patent Appeals, there can be no review of the Patent Office's determination as to

whether plaintiff is entitled to a patent. If plaintiff were to prevail in this mandamus action, his remedy would not include the grant of a patent.

Further, as defendants point out, plaintiff has not shown any of the Commissioner's decision to be arbitrary, capricious, and abuse of discretion, or otherwise contrary to the law. Rather, the uncontroverted evidence indicates that the Commissioner considered and responded to each of plaintiff's petitions of "communications". For instance, on February 13, 1986, the Commissioner responded Stagner's January 2, 1986 petition seeking reexamination and reconsideration of his application. The Commissioner stated in his response that he had reviewed the record and determined that the examiner had conducted a complete examination as to merit and form and that petitioner's other arguments related to the merits of

the examiner's rejection of the claim and that such questions are appealable to the board.

Moreover, on August 2, 1987, the Commissioner responded to Stagner's February 19, 1987 petition and to his complaints of discourteous conduct. In the response the Commissioner stated that a review of the record indicated no improper examiner procedures or conduct. The Commissioner went on to explain to plaintiff the difference between appealable and petitionable matters and advised him to obtain the services of a patent practitioner.

These responses are representative of the numerous responses made by the Commissioner to Stagner's petitions and communications, as more fully detailed in the court's finding of facts. Not only does it not appear to the court that the Commissioner's actions were arbitrary or capricious, it is clear

that the Commissioner went beyond his duty on several occasions in an attempt to assist the plaintiff with some to the conceptual and procedural difficulties he seemed to have with the patent process.

Under these circumstances, the court has not hesitation in finding that the plaintiff has failed to allege any instance in which the patent procedure denied him due process, or any situations in which the Commissioner acted arbitrarily, capriciously, or contrary to the law.

IT IS ACCORDINGLY ORDERED this 28 day of June, 1989, that defendants motion for summary judgment is granted.

IN THE UNITED STATES COURT FOR THE
DISTRICT OF KANSAS

87-1714-K

IRVIN D. STAGNER,

Plaintiff,

V.

UNITED STATES PATENT & TRADEMARK OFFICE,
et al.,

Defendants.

ORDER GRANTING MOTION TO RECONSIDER

On June 24, 1988, the court entered a Memorandum Order in Stagner v. United States Patent and Trademark Office, et al., Civil Action No. 87-1713-K, granting plaintiff's motion to reconsider the court's Memorandum and Order of May 9, 1988. Consistent with the June 24 order, plaintiff's motion to reconsider the May 9, 1988 order in this companion case is granted.

IT IS SO ORDERED this 28 day of June, 1988.

IN THE UNITED STATES COURT FOR THE
DISTRICT OF KANSAS

87-1713-K FILED JUN 24/88

IRVIN D. STAGNER,
Plaintiff,

V.

UNITED STATES PATENT & TRADEMARK OFFICE,
et al.,

Defendants.

MEMORANDUM ORDER

This matter is before the court on plaintiff Irvin D. Stagner's motion for the court to reconsider its memorandum and order of May 9, 1988, in which it dismissed plaintiff's complaints due to lack of subject matter jurisdiction and improper venue. The court based its decision on 35 U.S.C. §§ 135, 141 and 145, which provide that an applicant whose patent is denied may appeal to the Board of Patent Appeals, and if dissatisfied with that decision, may

appeal only to the Federal District Court for the District of Columbia or the Court of Appeals for the Federal Circuit. It appeared to the court that plaintiff had failed to exhaust his administrative remedies, although the procedural history was difficult to discern from plaintiff's prolix, pro se complaints.

The plaintiff has now filed his motion to reconsider. Up careful review of the same, the court is now convinced that it may exercise subject matter jurisdiction over this case.

The court now garners that following the examiner's rejection of plaintiff's patent application for reasons other than on its merits, the plaintiff petitioned the Commissioner of Patents and Trademarks as authorized by 37 C.F.R. @1.181(a). The commissioner subsequently dismissed the petition. Plaintiff now alleges

that the commissioner's action violated his constitutional right to due process, and he seeks review in this court.

The express statutory avenues of judicial review discussed by this court in its order of May 9, 1988, are limited to rejection of claims on the merits by the Board of Patent Appeals. However, decisions of the commissioner may be reviewed by way of mandamus. All federal district Courts have subject matter jurisdiction over such review actions pursuant to 28 U.S. C. @1338, covering all actions arising under the patent laws, and 28 U.S.C. @1361, covering actions for mandamus. Service of process and venue are authorized in the district of plaintiff's residence. 28 U.S.C. @@1361, 1391(e).

Mandamus will lie to provide jurisdiction to a federal court in order to define and compel compliance with due process requirements or to compel the

official to comply with the law when the claim is clear and certain that the duty of the officer is purely ministerial. *Lee Pharmaceuticals v. Creps.*, 577 F. 2d 610 (9th Cir. 1978). Of course, the patent applicant must have exhausted his administrative remedies before mandamus will lie. See *United States ex rel Steinmetz v. Allen*, 192 U.S. 543 (1904).

Upon review, it appears that plaintiff has at least alleged a due process violation and that this court may assert jurisdiction pursuant to 28 U.S.C. §§ 1338 and 1361. The complaint herein is of such importance to the litigant, and the area of the law is so complex, that plaintiff Stagner is advised by the court to obtain counsel in this matter and to have counsel file amended complaints which comply with Fed.R.Civ.P. 8. At that time, the court may reevaluate the existence of subject matter jurisdiction in this case.

IT IS ACCORDINGLY ORDERED this 24 day of June, 1988, that plaintiff's motion to reconsider the court's order of May 9, 1988 is granted. Plaintiff is further advised to obtain counsel in this matter or to show cause as to why the should not. The parties are further ordered to appear for status conference in chambers on August 15, 1988, at 1:00 P.M.

UNITED STATES COURT FOR THE DISTRICT OF
KANSAS

87-1715-K FILED MAY 10/88

IRVIN D. STAGNER,

V.

UNITED STATES PATENT & TRADEMARK OFFICE,
et al

JUDGMENT IN A CIVIL CASE

 Jury Verdict. This action came before the Court for a trial by jury. the issues have been tried and the jury has rendered its verdict.

XX Decision by the Court. This action came to trial or hearing before the Court. The issues have been tried or heard and a decision has been rendered.

IT IS ORDERED AND AJUDGED pursuant to Memorandum and Order filed May 9, 1988, defendants' motion to dismiss is granted.

ORDERED that plaintiff, Irvin D. Stagner, shall take nothing, the action is dismissed, and the defendants, United States Patent and Trademark Office, et al, shall recover of plaintiff their costs of action.

IN THE UNITED STATES COURT FOR THE
DISTRICT OF KANSAS

87-1714-K

IRVIN D. STAGNER,

Plaintiff,

V.

UNITED STATES PATENT & TRADEMARK
OFFICE,
et al

Defendants.

ORDER OF DISMISSAL

On May 9, 1988, the court entered a Memorandum and Order granting defendants' motion to dismiss the complaint of the Plaintiff in the Stagner v. United States Patent and Trademark Office, et al., Civil Action No. 87-1715-K. Consistent with the conclusions of law and findings of fact set forth therein, the court finds that this companion case should be dismissed.

IT IS SO ORDERED this 9 day of May, 1988.

UNITED STATES COURT FOR THE DISTRICT
OF KANSAS

87-1713-K

87-1714-K

87-1715-K

IRVIN D. STAGNER,

v.

UNITED STATES PATENT & TRADEMARK OFFICE,
et al

TAKE NOTICE that the above-entitled case
has been set for hearing (see above) at
3:00 P.M. , on April 4 1988, at the
United States Courthouse, Wichita,
Kansas, Room 232, before the Honorable
Patrick F. Kelly, Judge.

Dated February 26, 1988.

To Mr. Irvin D. Stagner

Mr. Stephen K. Lester

Plaintiff's response due on or before
3-21-88

Defendants' reply due on or before
3-28-88

APPENDIX VERBATIM
TITLE 35 U.S.C.A.
INVENTIONS PATENTABLE

35 U.S.C.A. 101

Whoever invents or discovers any new and useful process, machine, manufactures, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

CONDITIONS FOR PATENTABILITY;
NOVELTY AND LOSS OF RIGHT TO PATENT

35 U.S.C.A. 102

A person shall be entitled to a patent unless--

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representative or assigns in a foreign country prior to the date of the application for patent in this country on a application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United

States before the invention thereof by the applicant for Patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of this section 371(c) of this title before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, Suppressed, or concealed it. in determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from time prior to conception by the other.

CONDITIONS FOR PATENTABILITY;

NON-OBVIOUS SUBJECT MATTER

35 U.S.C.A. 103

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

APPEAL TO COURT OF APPEALS FOR THE
FEDERAL CIRCUIT

35 U.S.C.A. 141

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Appeals for the Federal Circuit, THEREBY WAVING HIS RIGHT TO PROCEED UNDER SECTION 145 OF THIS TITLE.

CIVIL ACTION TO OBTAIN PATENT

35 U.S.C.A. 145

An applicant dissatisfied with the decision of the Board of Appeals may UNLESS APPEAL HAS BEEN TAKEN TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, have remedy by civil action against the commissioner in the United States District Court for the district of Columbia if commenced within such decision.....

BENEFIT OF EARLIER FILING DATE

IN THE UNITED STATES

35 USC 120

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is file by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting of abandonment of or termination of proceedings on the first application or on an application similarly entitle to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

FIRST TITLE 35 U.S.C.A AND 37 C.F.R.

NATURE OF EXAMINATION; EXAMINERS ACTION
37 CFR 1.104

(a) On taking up an application for examination or a patent in reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matter of form, unless otherwise indicated.

(b) The applicant, or in the case of reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The

reasons for any adverse action or any objection or requirement will be stated and such information or reference's will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

COMPLETENESS OF EXAMINER'S ACTION

37 CFR 1.105

The examiner's action well be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defect in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matter of form need not be raised by the examiner until a claim is found allowable.

REJECTION OF CLAIMS

37 CFR 1.106

(a) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those consider unpatentable will be rejected.

(b) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his command. When reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(c) In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a

reexamination preceeding, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon fact within his or her knowledge pursuant to

CITATION OF REFERENCES

37 CFR 1.107

(b) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject contradiction or explanation by affidavits of the applicant and other persons.

CONTINUATION OR DIVISIONAL
APPLICATION FOR
INVENTION DISCLOSED IN PRIOR
APPLICATION

37 CFR 1.60

(a) A continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121 [35 U.S.C.A. 120 or 121] and 1.78 (a), which discloses and claims only subject matter disclosed in a prior application may be filed as a separate application before the patenting or abandonment of or termination of proceeding on the prior application.

(d) If an application which has been accorded a filing date pursuant to paragraph (a) of this section does not include the appropriate basic filing fee pursuant to paragraph (b) of this section, or an oath or declaration by the applicant in the case of a

continuation-in-part application
pursuant to paragraph (c) of this
section, applicant can be so notified
and given a period of time within which
to file the fee, oath, or declaration
and to pay the surcharge as set forth
in 37 CFR 1.16(e) in order to prevent
abandonment of the application. The
notification pursuant to this paragraph
may be made simultaneously with any
notification of a defect pursuant to
paragraph (a) of this section.

REPLY BY APPLICANT OR PATENT OWNER

37 CFR 1.111

(a) After the Office action, if adverse
in any respect, the applicant or patent
owner, if he or she persist in his or
her application for a patent or
reexamination proceeding, must reply
thereto and may request reconsideration
or further examination, with or without
amendment.

(b) In order to be entitled to reconsideration of further examination, the applicant or patent owner must make request therefor in writing. The reply by the applicant or patent owner must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office action. If the reply is with respect to an application, request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the case to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentability

distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections (See 1.135 and 1.136 for time for reply).

RECONSIDERATION

37 CFR 1.112

After response by applicant or patent owner (1.111), the application or patent under reexamination will be reconsidered and again examined. The applicant or patent owner will be notified if claims are rejected, or objections or requirement made, in the same manner as after the first examination. Applicant or patent owner may respond to such Office action in the same manner provided in 1.111, with or without amendment. Any amendments after the second Office action must ordinarily be restricted to the rejection or to the objections or requirements made. The application or patent under reexamination will be again considered, and so repeatedly, unless the examiner has indicated that the action is final.

FINAL REJECTION OR ACTION

37 CFR 1.113

(a) On the second or any subsequent examination or consideration the rejection or other action may be made final, whereupon applicant's or patent owner's response is limited to appeal in the case of rejection of any claim (1.191), or to amendment as specified in 1.116.

Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (1.181).

Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim.

If any claim stands allowed, the response to a final rejection or action must comply with and requirements or objection as to form.

(b) In making such final rejection, the

examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the case, clearly stating the reasons therefor. is final.

FINAL REJECTION OR ACTION

37 CFR 1.115

The applicant may amend before or after first examination and action and also after the second action or subsequent examination or reconsideration as specified in 37 CFR 1.112 or when and as specifically required by the examiner. The patent owner may amend in accordance with 37 CFR 1.510(e) and 1.510(b) prior to reexamination, and during reexamination in accordance with 37 CFR 1.112 and 37 CFR 1.116.

AMENDMENTS AFTER FINAL ACTION

37 CFR 1.116

(a) After final rejection or action (37 CFR 1.113) amendments may be made cancelling claims or complying with any requirement of form which has been made. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of or refusal to admit any amendment after final rejection and any proceedings relative thereto shall not operate, to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under 37 CFR 1.135.

(b) If amendments touching the merits of the application or patent under

reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon sufficient reason why they are necessary and were not earlier presented.

(c) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in 37 CFR 1.198, or to carry into a recommendation under 37 CFR 1.196.

PETITION TO THE COMMISSIONER

37 CFR 1.181

(a) Petition may be taken to the Commissioner:

(1) From any action or requirement of any examiner in the ex parte prosecution of an application which is not subject to appeal to the Board of Appeals or to the court;

(2) in cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and

(3) to invoke the supervisory authority of the Commissioner in appropriate circumstances.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must

accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution for an application, it may be required that there have been a proper request for reconsideration (1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the

Commissioner.

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings.

(g) The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

APPEAL TO THE BOARD OF APPEALS AND INTERFERENCES

37 CFR 1.191

(A) Every applicant for a patent or a reissue of a patent, or every owner of a patent under reexamination, any claims of which have been twice rejected or who has given a final rejection (1.113), may, upon the payment of the fee set

forth in 1.17(e) appeal from the decision of the examiner to the Board of Patent Appeals and Interferences within the time allowed for response.

28 USC 1654

APPEARANCE PERSONALLY OR BY COUNSEL

"In all courts of the United States the parties may plead and conduct their own cases personally or by counsel as, by the rules of such courts, respectively are permitted to manage and conduct causes therein. June 25, 1918, c. 616, 62 Stat. 944; May 24, 1949, c. 139, USC 91, 63 Stat. 103.



actions on the record made before the administrative agency;

4. Forfeiture proceedings.

At the conclusion of the pretrial proceedings, the pretrial order shall be filed with the clerk. Issue shall then be deemed joined, and the case will be ready for trial.

The pretrial order in in all civil non-jury cases shall require each of the parties to file with the clerk, within a time certain:

a. A summary of the anticipated testimony of the witnesses, and other evidence the party plans to offer;

b. A trial brief or memorandum of law; and,

c. Proposed findings of fact and conclusions of law.

In cases based on 42 U.S.C. Section 2000e-2, 2000e-3, and 2000e-5, within

120 days after the pretrial order is filed, the judge shall either cause the case to be tried or appoint a master, pursuant to Rule 53, Federal Rules of Civil Procedure, to take the evidence.

60 Am Jur 2d

@495. Final rejection or action

The examiner may make final the rejection or other action on a claim after the second or any subsequent examination or reconsideration.(45) The claims may be finally rejected in the first Patent and Trademark Office action only in the case of a continuing or substitute application. (46) Any question as to the prematurity of a final rejection should be raised while the case is still pending before the primary examiner, and the question is reviewable by petition to the Commissioner of Patents and

Trademarks.(47) In making such final rejection, the examiner must repeat or state all the grounds of rejection

(45) 37 CFR @@ 1.112.

(46) MPEP (5th ed) @@706.07(b).

(47) MPEP (5th ed) @@706.07(c).

then considered applicable the claims in the case and clearly state the reasons therefor.(48)

The applicant's response to a final rejection or action must include cancellation of or appeal from the rejection of each rejected claim, and for any claim which stands allowed, the applicant must comply with any requirement or objection as to form. (49)

(48) 37 CFR @@ 1.113(b).

(49) 37 CFR @@ 1.113(a).

XV. PETITION TO THE
COMMISSIONER [@@ 566-575]

A. In General [@@ 556-571]

Research References

37 CFR @@ 1.181-1.184

ALR Digest to 3d. 4th,

and Federal, Patents @@ 12

Index to Annotations, Patents

13 Federal Procedural Forms, I.Ed,

Patents @@ 52:31 et seq.

@@566. Generally; matters petitionable
and not appealable

A petition may be taken to the
Commissioner of Patents and Trademarks
from any action or requirement of a
patent examiner in the ex parte
prosecution of an application which is
not subject to appeal to the Board of
Patent Appeals and Interferences or the
U.S. Court of Appeals for the Federal
Circuit.(20) Traditionally, in such

(20) 38 CFR @@1.181(a)(1).

cases, an examiner's ruling dealing with procedural matters are reviewable upon petition to the Commissioner, while substantive questions dealing with patentability are reviewable by the Board and the court,(21) and where a petitioner has the right to appeal or file a civil action, review by the Commissioner is not appropriate.(22)

Petitions may also be taken to the Commissioner when a statute or rule specifies that the matter is to be determined directly by the

(21) Application of Searles, 57 CCPA 912, 422 F2d 431, 164 USPQ 623; Application of Newton 56 CCPA 1463, 414 F2d 1400, 163 USPQ 34.

(22) Giraldi v. Carney (Comr Pats) 207 USPQ 230.

For a discussion of those matter which

are appealable to the Board of Patent Appeals and Interferences, see @@743 et seq.

Commissioner, (23) or, when appropriate, to invoke the Commissioner's supervisory authority. (24)

(23) 37 CFR @@1.181(a)(2).

Practice Aids.--Petition to Commissioner--for retroactive licenses for foreign filing. 13 FEDERAL PROCEDURAL FORMS. L ED. PATENTS @@52:32.

Petition to Commissioner--To make special 13 FEDERAL PROCEDURAL FORMS L Ed. PATENTS @@52:33.

Petition to Commissioner--To reverse decision denying applicant retroactive license--Application inadvertently filed abroad and does not disclose invention subject to secrecy. 13 FEDERAL PROCEDURAL FORMS. L Ed. PATENTS @@52:34.

(24) 37 CFR @@ 1.181(a)(3).

Practice Aids.--Petition to Commissioner--To exercise supervisory authority and direct examiner to provide report of examination of

claims as to chemical
compound--Rejection of claims
has been asserted by their
withdrawal from further
consideration. 13 FEDERAL
PROCEDURAL FORMS. L Ed PATENTS
@@ 52:31.

petition to Commissioner--To
vacate examiner's requirement
to cancel certain words from
specifications. 13 FEDERAL
PROCEDURAL FORMS, L Ed. PATENTS
@@52.35

@@567. Necessity of request for
reconsideration

When the petition is taken from an
action of an examiner in the ex parte
prosecution of an application, a proper
request for reconsideration (25) and
repeated action by the examiner may be
required before review is granted.(26)
A petition for review of an examiner's
requirement that the applicant elect the
invention to which his claim shall be
restricted will not be considered if
reconsideration of the requirement was
not requested.(27)

@@ 568. Petition; content and response

The petition must contain a statement of the facts involved, the points to be reviewed, and the action

(25) As to request for reconsideration, see @@ 193

(26) 37 CFR @@ 1.161(c).

(27) 37 CFR @@ 1.144.

requested. (28) Any briefs or memoranda in support of the petition must accompany or be embodied in the petition and, where fact are to be proven, proof in the form of affidavits, declarations, or exhibits must accompany the petition. (29)

While the regulations do not provide for the filing of documents in opposition to the petition, the Commissioner of Patents and Trademarks will consider a respondent's response in appropriate cases. (30)

***Caution: The appropriate section of the Rules of

(28) 37 CFR @@ 1.181(b)

(29) 37 CFR @@ 1.181(b).

(30) Guzman v. Schept (Comr Pats) 207
USPQ 220, petition den (Comr Pats) 207
USPQ 222.

indicate whether a fee is required for a petition to the Commissioner.(31) Any petition on a question not specifically provided for in the Rules must be accompanied by a set fee.(32) A petition which is not accompanied by the required fee will be dismissed. (33)

@@ 569. --Time for filing

Except as otherwise provided in the Rules of Practice in Patent Cases, a petition must be filed within 2 months

of the action complained of, or it may

(31) 37 CFR @@ 1.181(d).

For a list of the required fees for petitions, see 37 CFR @@ 1.17(h)-(m).

(32) 37 CFR @@ 1.182.

(33) 37 CFR @@ 1.181(d).

be dismissed as untimely. (34) Filing a petition will not stay the period for reply to an examiner's action which may be running against an application or act as a stay of any other proceeding.(35)

@@570. Hearing and determination

Oral hearing will not be granted except when considered necessary by the Commissioner of Patents and Trademarks,(36) and it is not the Commissioner's practice to grant such hearings.(37) Cases not specifically provided for in the Rules of Practice in

Patent Cases are decided in accordance with their merits communicated to the interested parties in writing.(38)

(34) 37 CFR @@ 1.181(f).

(35) 37 CFR @@ 1.181(f).

(36) 37 CFR @@ 1.181(c).

(37) Chauvette v. Scartazzini
(Cmmr Pats) 206 USPQ 764.

Cases which have been decided by one Commissioner will not be reconsidered by a successor Commissioner except in accordance with the principles governing the granting of a new trials.(39)

@@ 571. Suspension or waiver of rules

An interested party may petition the Commissioner of Patents and Trademarks, in a extraordinary situation and when justice requires, for a waiver of suspension of any requirement of the Rules of Practice in Patent Cases which

is not a requirement of the statutes. (40) To justify such a

(38) 37 CFR 1.182.

(39) 37 CFR @@ 1.184.

(40) 37 CFR @@ 1.183.

suspension of the rules, the petitioner must demonstrate the existence of an extraordinary situation in which justice requires the suspension, (41) and it is not sufficient merely to show that no special damage would result from any suspensions. (42) Of course, a suspension which would be contrary to statutory requirements is improper, (43) but it has been held that a rule requiring civil actions to be commenced within 60 days of Patent and Trademark Office decisions, which was adopted pursuant to the Commissioner's statutory

—(41) Nichols v. Sayman (Comr Pats) 210 USPQ 301; Dingwall v. Morozumi (Comr Pats) 207 USPQ 1137.

(42) Myers v. Feigelman, 59
CCPA 834, 455 F2d 596, 172
USPQ 580, later app (CCPA) 476
F2d 1375, 177 USPQ 530

(43) Re AMP. Inc. (commr Pats)
212 USPQ 826.

authority to "appoint" the time within which such actions must be taken, to be not less than 60 days, (44) is not a requirement of the statutes and can be waived. (45) When the Commissioner determines that a suspension is proper, he may, in his discretion, select the particular remedy he deems most appropriate. (46)

(44) For a discussion of the time for filing a civil action to obtain a patent, see @783.

(45) Eckey v. Watson, 106 App DC 16, 268 F2d 891, 122 USPQ 5.

(46) Mobil Oil Cor. v. Dann (DC Dist Col) 421 JF.Supp 995. 197 USPQ 59, later app (DC Dist Col) 448 F.Supp 487, 198 USPQ 347.

B. Judicial Review of
Commissioner's Decisions [@@ 572-575]

Research References

35 USCS @@141

ALR Digest to 3d, 4th, and Federal,
Patents @@ 12

Index to Annotations, Patents

19 Am Jur Pl & Pr Forms (Rev), Patents,
Form 7

@@ 572. Jurisdiction of District Court

The Court of Appeals for the Federal Circuit (formerly the Court of Customs and Patent Appeals) is given jurisdiction only over appeals from the Board of Patent Appeals and Interferences.(47) Therefore, review of the decisions of the Commissioner of Patents and Trademarks on petitions is available only in District Court.(48)

(47) 35 USCS @141

(48) Re Makari (CA FC) 708 F2d
709, 218 USPQ 247.

@@ 573. Review by way of mandamus

Decisions of the Commissioner of Patents and Trademarks on petitions are reviewable in District Court by mandamus.(49) However, such relief is limited to situations where the Commissioner's decision on the petition violates a duty owed to the plaintiff and is not available where the Commissioner's decision is discretionary in nature.(50)

The Court of Appeals for the Federal Circuit may issue a writ of mandamus to review a decision of the Commissioner only if they decision would otherwise frustrate the Court's prospective jurisdiction on appeal from an eventual decision of the Board of Appeals or Board of Patent Interferences.(51)

(49) Application of Mindick, 54 Cust & Pat App 1053, 371 F2d 892; Application of Wiechert, 54 CCPA 957, 370 F2d 927, 142 USPQ 247.

petition for writ of mandamus directing trial court to vacate order directing patent owner to petition Patent And Trademark Office (PTO) to revive abandoned reissue application for expired patent is denied as premature where PTO has not yet been petitioned and formally denied or granted petition. Baker Perkins, Inc. v. Wermer & Pfleiderer Corp. (CA FC) 710 F2d 1561, 218 USPQ 577.

(50) Godtfredsen v.
Banner (DC Dist Col) 297 USPQ
202.

Practice
Aids--Complaint--In District
Court--In nature of
mandamus--To compel
Commissioner of Patents and
Trademarks to issue
retroactive license for
foreign filing. 19 Am Jur Pt.
& PR FORMS (Rev), PATENTS,
Form 7.

(51) RE Makari (CA FC)
708 F2d 709, 218 USPQ 193.

@@ 574. Review under Administrative Procedure Act

Review of the decision of the Commissioner of Patents and Trademarks which constitute final agency action such as the denial of a retroactive license for a foreign patent, (52) is available under the Administrative Procedure Act. (53) However, the only review provided for under the APA is review of final agency actions and not the review of a procedural order. (54) and review of the Commissioner's interlocutory decisions in not available. (56)

(52) Reese v. Dann (DC Dist Col) 391 F Supp 12, 185 USPQ 492.

(53) 5 USJCS @@701 et seq.

(54) Eastman Kodak Co. v. Mossinghof CA4 Va) 704 F2d 13129, 217 USPQ 1190 (review of examiner's decision denying a protest); Phillips Petroleum CO. v. Brenner, 127 App DC 319, 383 F2d 514, 154 USP 211, cert den 389 US 1042, 19 L Ed

2d 833, 88 S Ct 785, 156 USPQ
720

(55) Klein v.
Commissioner of Patents (CA4
Va) 474 F2d 821, 177 USPQ 1;
Godtfedsen v. Banner (DC Dist
Col) 297 USPQ 202.

(56) @@ 573.

@@ 575. What determinations are
reviewable

Mandamus will lie(56) or an action
under the Administrative Procedure Act
may be maintained,(57) to compel the
Commissioner of Patents and Trademarks
to permit amendment of a claim(58) or
revival of an abandoned application;(59)
to compel him to require an examiner to
forward an appeal to the Board of Patent
Appeals and Interferences; (60) or to
compel him to sign a patent.(61)

The District court cannot consider
striking patents for fraud at the behest
of the interference loser when the issue
was not raised or decided at the Patent
and Trademark Office.(62)

(57) @@ 574.

(58) Sikora v. Brenner,
126 App. DC 375, 379 F2d 134,
153 USPQ 585; Re Mindick, 54
CCPA 1053, 371 F2d 892, 152
USPQ 566.

(59) Commissariat A.
L'Energie Atomique v. Watson,
107 App DC 85, 274 F2d 594,
124 USPQ 566.

(60) United States ex
rel. Steinmets v. Allen, 192
US 543, 48 L Ed. 555, 24 S Ct
416

(61) Butterworth v.
United States, 112 US 50, 28 L
Ed 656, 5 S Ct 25.

(62) Wm. T. Burnett & Co.
v. General Tire & Rubber Co.
(DC Md) 545 f. Supp 794, 200
USPQ 223, affd without op (CA4
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